

This Opinion is Not a
Precedent of the TTAB

Mailed: August 16, 2023

UNITED STATES PATENT AND TRADEMARK OFFICE

—
Trademark Trial and Appeal Board

—
In re Federal Bar Foundation

—
Serial No. 90525583

Jennifer Lee Taylor of Morrison & Foerster LLP,
for Federal Bar Foundation.

Matthew Howell, Trademark Examining Attorney, Law Office 123,
Susan Hayash, Managing Attorney.

—
Before Cataldo, Lynch and Cohen,
Administrative Trademark Judges.

Opinion by Cohen, Administrative Trademark Judge:

I. Background

Applicant, Federal Bar Foundation, seeks registration on the Principal Register of the proposed mark WHEN THERE ARE NINE in standard characters for the following service in International Class 36: “providing educational scholarships.”¹

Representative samples of Applicant’s specimens of use in application Serial No.

¹ Application Serial No. 90525583 was filed on February 11, 2021, based on Applicant’s assertion of September 13, 2021, as a date of first use of the mark anywhere and in commerce under Section 1(a) of the Trademark Act, 15 U.S.C. § 1051(a).

Serial No. 90525583

90525583, described by Applicant as a “screenshot of a webpage advertising the service,” and “a press release reporting award recipients,”² are reproduced below.

Document title: When There Are Nine – Federal Bar Council
Capture URL: <https://www.federalbarcouncil.org/foundation/when-there-are-nine/>
Capture timestamp (UTC): Mon, 21 Mar 2022 22:16:14 GMT

Page 1 of 2

² April 1, 2022 Amendment to Allege Use at TSDR 1. Citations to the application record are to the TSDR database.

Ginsburg speaks during the lunch session of "The Women's Conference 2010" in Long Beach, California October 26, 2010. REUTERS/Mario Anzuoni

Register now for FREE unlimited access to Reuters.com

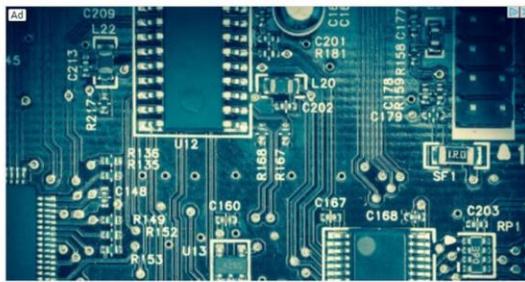
Register

- Law students at Yale, Stanford, Fordham and Columbia to receive \$10,000 and mentorship opportunities
- Donors include former U.S. Attorney Preet Bharara and Sullivan & Cromwell's Karen Patton Seymour

The company and law firm names shown above are generated automatically based on the text of the article. We are improving this feature as we continue to test and develop in beta. We welcome feedback, which you can provide using the feedback tab on the right of the page.

(Reuters) - A scholarship program honoring the career of late U.S. Supreme Court Justice Ruth Bader Ginsburg has named its inaugural class of awardees, choosing four first-year law students to receive a \$10,000 stipend and mentoring from a network of former New York federal prosecutors.

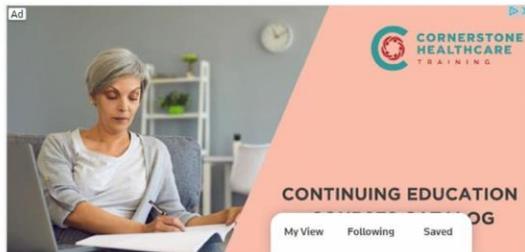
The When There Are Nine Scholarship Project was announced in May by a group of 33 women who served together as assistant U.S. attorneys in the Southern District of New York. Its first awardees are Amanda Gomez Feliz (Yale Law School), Priscilla Guo (Stanford Law School), Cristel Taveras (Fordham University School of Law) and Rose Wehrman (Columbia Law School).



Bioinformatics & Genomics PhD
Study the intersection of computational, evolutionary & functional genomics at Penn State!
thuck.psu.edu Visit Site

The women were chosen from 384 applicants for their "academic achievement, commitment to serving her community, and for her perseverance in the face of adversity," according to a press release.

The When There Are Nine program was named for an answer Ginsburg gave when asked when there will be "enough" women serving on the Supreme Court. It aims to provide assistance "that will advance equity and diversity within the legal profession and continue the late Justice's many efforts to expand career opportunities for women attorneys," the group said Monday.



CORNERSTONE HEALTHCARE TRAINING
CONTINUING EDUCATION
My View Following Saved

Report ad

My View Legal

- + Attorney Analysis
- + Capital Markets
- + Competitive Intelligence
- + COVID-19 + Employment
- + Intellectual Property
- + Litigation
- + Mergers & Acquisitions
- + People Moves
- + Supreme Court of the United States

Apply

Latest In Legal Industry

Supreme Court of the United States
U.S. Supreme Court pick Jackson stresses God and country amid Republican attacks

People Moves
BakerHostetler adds 19-member Morgan Lewis IP team in California

Energy
Willkie loses energy co-leader to rival in another Houston partner exit

Finance & Banking
Russian bank loses bid to pause U.S. case over sacred Jewish texts

Feedback

The Examining Attorney refused registration under Trademark Act Sections 1, 2, 3⁴ and 45, 15 U.S.C. §§1051-1053, and 1127, for failure to function as a mark on the basis that WHEN THERE ARE NINE “is an informational social, political, religious, or similar kind of message that merely conveys support of, admiration for, or affiliation with the ideals conveyed by the message.”⁵ Specifically, the Examining Attorney asserted that the proposed mark is a phrase that “is a commonly used message from Ruth Bader Ginsburg regarding women on the U.S. Supreme Court” and that Applicant’s specimen “indicates its scholarship’s purpose is to support Justice Ruth Bader Ginsburg’s message.”⁶

After the Examining Attorney made the refusal final, Applicant requested reconsideration and appealed. The Examining Attorney denied reconsideration and maintained the refusal. The appeal resumed, and Applicant and the Examining Attorney briefed the issues on appeal.

We affirm the refusal to register.

II. Failure to Function Refusal

A. Applicable Law

“An applicant’s proposed mark must, by definition, ‘identify and distinguish his or her goods [or services] ... from those manufactured or sold by others and ... indicate the source of the goods [or services], even if that source is unknown.’” *Univ. of Ky. v.*

⁴ Applicant seeks to register its proposed mark for services and as such, Trademark Act Section 3, 15 U.S.C. § 1053 is implicated.

⁵ May 3, 2022 Office Action at TSDR 1.

⁶ *Id.*

40-0, LLC, 2021 USPQ2d 253, at *24 (TTAB 2021) (quoting Trademark Act Section 45, 15 U.S.C. § 1127). “Hence, a proposed trademark is registrable only if it functions as an identifier of the source of the applicant’s goods or services.” *Id.*; see also *In re Bose Corp.*, 546 F.2d 893, 192 USPQ 213, 215 (CCPA 1976) (“[T]he classic function of a trademark is to point out distinctively the origin of the goods to which it is attached.”).

“Not every designation adopted with the intention that it perform a trademark function necessarily accomplishes that purpose.” *In re Lizzo LLC*, 2023 USPQ2d 139, at *4 (TTAB 2023) (quoting *In re Brunetti*, 2022 USPQ2d 764, at *10 (TTAB 2022)); *In re Tex. With Love, LLC*, 2020 USPQ2d 11290, at *2-3 (TTAB 2020) (quoting *In re Pro-Line Corp.*, 28USPQ2d 1141, 1142 (TTAB 1993) (“Mere intent that a phrase function as a trademark is not enough in and of itself to make it a trademark.”)); *D.C. One Wholesaler, Inc. v. Chien*, 120 USPQ2d 1710, 1713 (TTAB 2016) (granting petition to cancel registration on the Supplemental Register where “the marketplace is awash in products that display the term.”). Slogans, phrases or terms that consumers perceive as “merely informational in nature . . . are not registrable.” *In re Brunetti*, 2022 USPQ2d 764, at *11 (quoting *In re Eagle Crest, Inc.*, 96 USPQ2d 1227, 1229 (TTAB 2010) and citing additional cases). “Matter may be merely informational and fail to function as a trademark if it is a common term or phrase that consumers of the goods or services identified in the application are accustomed to seeing used by various sources to convey ordinary, familiar, or generally understood concepts or sentiments. Such widely used messages will be understood as merely conveying the

ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function.” *Id.* at *12; *see also In re Greenwood*, 2020 USPQ2d 11439, at *6 (TTAB 2020) (“Consumers ordinarily take widely-used, commonplace messages at their ordinary meaning, and not as source indicators, absent evidence to the contrary.”); *In re Mayweather Promotions, LLC*, 2020 USPQ2d 11298, at *1 (TTAB 2020) (“Widely used commonplace messages are those that merely convey ordinary, familiar concepts or sentiments and will be understood as conveying the ordinary concept or sentiment normally associated with them, rather than serving any source-indicating function”); *Texas With Love, LLC*, 2020 USPQ2d 11290, at *2 (TTAB 2020) (holding that TEXAS LOVE would be perceived not as a source identifier, but instead as a widely-used phrase that merely conveys a well-recognized and commonly expressed concept or sentiment); *D.C. One Wholesaler*, 120 USPQ2d at 1716 (finding I ♥ DC failed to function as a mark for clothing because it would be perceived merely as an expression of enthusiasm for the city).

“In analyzing whether a proposed mark functions as a source identifier,” the Board focuses on “consumer perception.” *In re Vox Populi Registry Ltd.*, 25 F.4th 1348, 2022 USPQ2d 115, at *2 (Fed. Cir. 2022); *see also Univ. of Ky.*, 2021 USPQ2d 253, at *25 (“The critical inquiry in determining whether a proposed mark functions as a trademark is how the relevant public perceives the term sought to be registered.”) (citing *In re Greenwood*, 2020 USPQ2d 11439, at *2). “[E]vidence of the public’s perception may be obtained from ‘any competent source, such as consumer surveys, dictionaries, newspapers and other publications.’” *Princeton Vanguard, LLC v. Frito-*

Lay N. Am., Inc., 786 F.3d 960, 114 USPQ2d 1827, 1833 (Fed. Cir. 2015) (quoting *In re Northland Aluminum Prods., Inc.*, 777 F.2d 1556, 227 USPQ 961, 963 (Fed. Cir. 1985)). Internet evidence can be relevant to show consumer perception. *In re Bayer AG*, 488 F.3d 960, 82 USPQ2d 1828, 1833 (Fed. Cir. 2007). “Where the evidence suggests that the ordinary consumer would take the words at their ordinary meaning rather than read into them some special meaning distinguishing the goods and services from similar goods and services of others, then the words fail to function as a mark.” *In re Ocean Tech., Inc.*, 2019 USPQ2d 450686, at *3 (TTAB 2019) (internal punctuation omitted).

We assess whether Applicant’s proposed mark, WHEN THERE ARE NINE, functions as a mark based on whether the relevant public, i.e. potential consumers of the identified scholarship services, would perceive WHEN THERE ARE NINE as identifying the source or origin of such services. *See e.g. In re Texas With Love, LLC*, 2020 USPQ2d 11290, at *2 (TTAB 2020) (“Whether the term ... falls within this definition and functions as a mark depends on whether the relevant public, i.e., purchasers or potential purchasers of Applicant’s goods [or services], would perceive the term as identifying the source or origin of Applicant’s goods [or services].”); *In re TracFone Wireless, Inc.*, 2019 USPQ2d 222983, at *1-2 (TTAB 2019) (“The key question is whether the asserted mark would be perceived as a source indicator for Applicant’s [goods or] services.”). Where, as here, “there are no limitations on the channels of trade or classes of consumers of the [services] identified in the application, the relevant consuming public comprises all potential [consumers of such services].”

Univ. of Ky., 2021 USPQ2d 253, at *25; *In re Team Jesus, LLC*, 2020 USPQ2d 11489, at *3 (TTAB 2020).

B. Arguments and Evidence of Record

The Examining Attorney argues that “the applied-for mark is an informational social, political, or similar kind of message that merely conveys support of, admiration for, or affiliation with the ideals conveyed by the message.”⁷ The Examining Attorney specifies: “The evidence of record shows that consumers are likely to perceive the mark as a quote from the late Justice Ginsburg ... [and] that the mark is used across different industries to advertise, market, and promote various goods and services and to indicate support for the quote’s message just as [A]pplicant does.”⁸

The Examining Attorney submitted evidence reflecting general use of the phrase to convey support for Justice Ruth Bader Ginsburg and her message in a variety of contexts (emphases added):

- An article on the Distractify website titled “Everyone Needs to Know What **‘When There Are Nine’** Means” attributing the quote to Ruth Bader Ginsburg and noting merchandise such as t-shirts are for sale that display **WHEN THERE ARE NINE** by Etsy sellers;⁹
- An article on the Genesis Women’s Shelter and Support website titled “**When There Are Nine: A Challenge from Justice Ginsburg**”

⁷ 8 TTABVUE 4.

⁸ *Id.* at 5.

⁹ September 21, 2021 Office Action at TSDR 4-7.

explaining that the quote and its meaning are part of Justice Ginsburg's legacy;¹⁰

- A post on the BNIM website titled “**When There Are Nine**” discussing the meaning and showing support for the quote's message;¹¹
- Screenshots from Dissent Pins of a video clip of Justice Ginsburg that attributes to her the quote “When I'm sometimes asked when will there be enough women on the Supreme Court and I say, ‘**When there are nine,**’ people are shocked. But there'd been nine men, and nobody's ever raised a question about that” and offers for sale a pin and sticker featuring the phrase **WHEN THERE ARE 9**;¹²
- Screenshot of a PBS News Hour video titled “When will there be enough women on the Supreme Court? Justice Ginsburg answer that question”, which goes on to read “And my answer is **when there are nine**”;¹³
- Screenshot of a Town & Country magazine article titled “12 Powerful Quotes from Ruth Bader Ginsburg” which includes the quote “When I'm sometimes asked ‘When will there be enough [women on the Supreme Court]?’ and I say ‘**When there are nine,**’ people are shocked. But there'd been nine men, and nobody's ever raised a question about that”;¹⁴

¹⁰ *Id.* at 8-9.

¹¹ May 3, 2022 Office Action at TSDR 2-3.

¹² *Id.* at 4-5.

¹³ *Id.* at 22-23.

¹⁴ *Id.* at 24-26.

- Screenshot of an article by Gloria Feldt titled “**When there are nine**’ and other powerful quotes about gender equality from Justice Ruth Bader Ginsburg”;¹⁵
- Screenshot from Good Reads displaying the quote “When I’m sometimes asked when will there be enough [women on the Supreme Court] and I say, **When there are nine,**’ people are shocked. But there’d been nine men, and nobody’s ever raised a question about that”;¹⁶ and
- Theater Review on the WTTW News website titled “In **When There are Nine,**’ a New Play About Ruth Bader Ginsburg, the End Triggers Memories of All that Came Before.”¹⁷

The Examining Attorney also submitted evidence which displays the WHEN THERE ARE NINE message on various items for sale as described below:

- Screenshots from Etsy offering for sale shirts, stickers, key chains, wall art, bags, and jewelry displaying **WHEN THERE ARE NINE;**¹⁸
- Google shopping webpages showing framed art, clothing, key chains, coffee mugs, drinkware, pillows, pins, cups, stickers, posters, bags, luggage wraps and tags, yard signs, face masks, jewelry, greeting cards, and mouse pads for sale all displaying **WHEN THERE ARE NINE;**¹⁹

¹⁵ August 4, 2022 Reconsideration Letter at TSDR 4-6.

¹⁶ *Id.* at 7.

¹⁷ *Id.* at 16-18

¹⁸ May 3, 2022 Office Action at TSDR 6-12.

¹⁹ *Id.* at 13-21.

Serial No. 90525583

- Art print for sale displaying **WHEN THERE ARE NINE** on Art.com;²⁰
- Ring for sale on Chocolate & Steel website which displays **WHEN THERE ARE NINE**;²¹
- Webpages from Red Bubble showing stickers, magnets, clothing, posters, masks, bags, and comforters for sale all of which display **WHEN THERE ARE NINE** and **WHEN THERE ARE 9**;²²
- The Feminista website showing t-shirts displaying **WHEN THERE ARE 9** for sale;²³ and
- Webpages from Zazzle, zazzle.com, showing shirts and magnets for sale that display **WHEN THERE ARE NINE**.²⁴

Representative samples of the Examining Attorney's evidence are reproduced below.

²⁰ August 4, 2022 Reconsideration Letter at TSDR 1-2.

²¹ *Id.* at 3.

²² *Id.* at 8-14.

²³ *Id.* at 15.

²⁴ *Id.* at 19-25.

A screenshot of a Google search results page for the query "when there are nine". The page displays a grid of 12 items for sale, including t-shirts, keychains, mugs, and pillows. Each item listing includes a price, the seller's name, and a small image of the product. The items are:

- Classic T-Shirt, Men's, Size: Adult S, Black - \$17.45 (Zazzle)
- Multi-Design Vintage Notorious RBG Vintage Poster, Notorious RBG Vintage Poster, Notorious RBG ... - \$9.99 (Etsy - DeeDeesGifts)
- There are Nine Shot Glass - \$8.15 (Zazzle)
- Ruth Bader Ginsburg Sweatshirt, Girl Power ... - \$22.79 (Etsy - SelenApparelUS)
- When There Are Nine Ruth Bader Ginsburg T-shirt, Women's, Size: Adult S, White - \$20.50 (Zazzle)
- RBG Quote - When There Are Nine Keychain, Adult Unisex, Pale Blue - \$14.05 (Zazzle)
- When There Are Nine Rbg Mug Ruth Bader Ginsburg Coffee Mug Feminist Mug Justice ... - \$19.95 (Etsy - FruitbatandCoffee)
- When There Are Nine Throw Pillow | Redbubble Ruth Bader Ginsburg Throw Pillow - \$23.12 (Redbubble)
- Ruth Bader Ginsburg Mug, When There are Nine Latte Mug - \$14.05 (Zazzle)
- RBG - When There Are Nine - S - \$14.05 (Zazzle)
- Ruth Bader Ginsburg | When There Are Nine Laser Etched Tumbler | Piper Lou, 12oz ... - \$19.95 (Etsy - FruitbatandCoffee)
- When There Are Nine Rbg Pin | When There Are Nine Rbg Quote - \$23.12 (Redbubble)

The timestamp at the bottom left of the screenshot is 2:16:27 PM 5/3/2022.

A screenshot of a Google search results page for the query "when there are nine". The page displays a grid of 12 items for sale, including water bottles, wallet cases, mugs, baseball caps, and posters. Each item listing includes a price, the seller's name, and a small image of the product. The items are:

- Sparkle Silver ... - \$24.95 (Rockaway Gypsy)
- Mousepad - \$12.99 (Appy 000LE15 Tee Shirt Palace)
- Portrait Poster ... - \$8.77 (Etsy - audreestore)
- Quote Poster ... - \$3.90 (Etsy - PressBro)
- Rbg When There Are Nine Glossy Sticker | Redbubble Ruth Bader Ginsburg Glossy Sticker - \$3.54 (Redbubble)
- Notorious RBG - When there are nine iPhone 8/7 Wallet Case - \$29.30 (Zazzle)
- RBG When There Are Nine Mug by Happy Trails Home - \$19.95 (Fantastic)
- ...When There Are Nine. - Ruth Bader Ginsburg Flexfit Baseball Cap - \$26.95 (i-Funny.com)
- Ruth Bader Ginsburg Vintage Poster, Notorious RBG Vintage Poster, Notorious RBG ... - \$29.30 (Zazzle)
- Art Print: Ruth Bader Ginsburg - When There Are Nine : 18x12in - \$29.30 (Zazzle)
- Framed Art Print: Ruth Bader Ginsburg - When There Are Nine. 22x16in. - \$29.30 (Zazzle)
- RBG Quote: When there are nine. Ruth Bader Ginsburg. RBG. Political quote. - \$26.95 (i-Funny.com)

The timestamp at the bottom left of the screenshot is 2:21:45 PM 5/3/2022.

The screenshot shows a web browser window with the URL [distractify.com/p/when-there-are-nine-meaning](https://www.distractify.com/p/when-there-are-nine-meaning). The page features the Distractify logo and navigation links for Entertainment, Trending, Influencers, and Gaming. The main content is an article titled "Everyone Needs to Know What 'When There Are Nine' Means" by Gina Vaynshteyn, dated December 24, 2020. The article includes a photograph of Justice Ruth Bader Ginsburg speaking at a podium. The text of the article discusses her advocacy for women's equality and the significance of the phrase "When there are nine".

This screenshot shows the same web browser window, but the article content has scrolled down to a section titled "You can buy 'When there are nine' merch." The text encourages readers to support the fight for equality by purchasing merchandise. Below the text is a photograph of a black t-shirt with the phrase "when there are nine" written in white cursive script. The t-shirt is displayed alongside a pair of blue jeans, a brown leather messenger bag, and a pair of brown shoes. The browser's address bar and navigation menu remain visible at the top of the page.

As noted in *D.C. One Wholesaler*, “[t]he widespread ornamental use of the phrase [I ♥ DC] by third parties ‘is part of the environment in which the [mark] is perceived by the public and . . . may influence how the [mark] is perceived.’” 120 USPQ2d at 1716 (citations omitted).

Applicant argues that the Examining Attorney’s evidence is largely “dated immediately after Justice Ginsburg’s death” and that “[a]t best, . . . show an interest at the time of Justice Ginsburg’s passing in her life and work; they do not establish that WHEN THERE ARE NINE has an ordinary meaning or is commonly used.”²⁵ Applicant further argues that there is no indication regarding consumer exposure to the Examining Attorney’s evidence and that Applicant’s proposed mark requires “context for it to be understood, and the [Examining Attorney’s] articles, blog, and theater review all include that context.”²⁶

In prior Board cases, we have found because “the consumer perception of the message . . . determine[s] whether or not the proposed mark could identify a single source and thus be registrable. . . . *any* evidence demonstrating widespread use of the wording is relevant.” *In re Deporter*, 129 USPQ2d 1298, 1302 (TTAB 2019) (emphasis in original). Further, there is no specific rule as to the exact amount of evidence necessary to prove informational use. *See Hunter Publishing Co. v. Caulfield Publishing Ltd.*, 1 USPQ2d 1996, 1999 (TTAB 1986) (“[e]valuation of the evidence requires a subjective judgment as to its sufficiency based on the nature of the mark

²⁵ 6 TTABVUE 6-7.

²⁶ *Id.* at 7.

and the conditions surrounding its use.”). After careful consideration of the evidence of record, we find that the evidence submitted by the Examining Attorney is sufficient to show widespread use. In addition to use of the wording by the media and in various online articles, as well as in the title of a play, the record shows use by numerous third-party sources of goods. All of this evidence shows that consumers would not perceive this wording as the indicator of a single source. Rather, the record indicates that consumers would recognize the wording as conveying a message through use of a quote that is widely known to the public.

Applicant asserts that its specimen shows its use of the proposed mark “featured prominently in large, black typeface that is bolded and capitalized”;²⁷ and that its proposed mark “repeatedly appears larger than the surrounding text and is set apart from the other informational matter”²⁸ such that it is perceived as an indication of source and “not merely a common place phrase.”²⁹ Applicant further argues that the cases relied upon by the Examining Attorney, namely, *In re Wal-Mart Stores, Inc.*³⁰ (refusal of INVESTING IN AMERICA displayed on signage in stores) and *In re Hulting*³¹ (refusal of NO MORE RINOS! displayed on merchandise), are inapposite to Applicant’s intended use asserting that “[t]here is no record evidence here that

²⁷ *Id.* at 9.

²⁸ *Id.* at 10.

²⁹ *Id.* at 11.

³⁰ 129 USPQ2d 1148, 1150 (TTAB 2019).

³¹ 107 USPQ2d 1175, 1177 (TTAB 2013).

Applicant's mark is similarly informational about its services—educational scholarships.”³²

The fact that Applicant displays WHEN THERE ARE NINE in the manner of a service mark does not require a different result because the question is whether the proposed mark is such a commonplace expression that it would not be perceived a source indicator, not the particular mode or manner in which the mark is presented. *D.C. One Wholesaler*, 120 USPQ2d at 1716 (“The fact that Respondent has sometimes displayed I ♥ DC on hangtags and labels, in a non-ornamental manner that is conventional for the display of trademarks, does not require a different result.”); *In re Team Jesus LLC*, 2020 USPQ2d 11489, at *5 (same) (quoting *D.C. One Wholesaler*, 120 USPQ2d at 1716). Because of the nature and ubiquity of the phrase WHEN THERE ARE NINE, “the mere fact that [A]pplicant’s slogan appears on the specimens, even separate and apart from any other indicia which appear on them, does not make it a trademark.” *In re Wal-Mart Stores, Inc.*, 129 USPQ2d at 1152.

Also, we disagree with Applicant’s argument that no evidence reflects an informational use in connection with its services. Applicant’s website, submitted as a specimen, reinforces WHEN THERE ARE NINE as a recognized quote by Justice Ginsburg conveying her message and Applicant’s support for it. For example, Applicant’s webpage reads:

The When There Are Nine Scholarship Project was established in 2020 ... by a group of women attorneys who served together as Assistant United States Attorneys in the Southern District of New York. The Project’s mission is

³² 9 TTABVUE 4.

to honor the lifelong work of the late Justice Ruth Bader Ginsburg by creating a scholarship and related programming that will advance equity and diversity within the legal profession and continue the late Justice's many efforts to expand career opportunities for women attorneys.³³

See In re Wal-Mart, 129 USPQ2d at 1152 (the text on Applicant's website confirms the merely informational nature of the phrase). In the submitted press release, the scholarship is described as a "program honoring the career of late U.S. Supreme Court Justice Ruth Bader Ginsburg."³⁴

Consideration of Applicant's specimens and evidence makes clear that consumers would perceive use of WHEN THERE ARE NINE as merely an informational statement in support of Justice Ginsburg and women in the legal profession rather than a service mark. Thus, the commonplace meaning imparted by the phrase would be the meaning impressed upon the consuming public.

In further support of its argument that WHEN THERE ARE NINE is a source identifier, Applicant lists the following third party registrations for scholarships along with TSDR printouts:

- ALL FOR ONE AND ONE FOR ALL (Reg. No. 6,670,869)
- IF NOT ME, THEN WHO... (Reg. No. 4,405,592)
- INVEST IN BALTIMORE (BALTIMORE disclaimed) (Reg. No. 3,743,858)
- I HAVE A DREAM FOUNDATION (FOUNDATION disclaimed) (Reg. No. 2,100,559)
- WOMAN OF HER WORD (Reg. No. 5,675,854)

³³ April 1, 2022 Specimen at TSDR 2.

³⁴ *Id.* at 4.

- BE A LEADER FOUNDATION (FOUNDATION disclaimed) (Reg. No. 5,354,302)
- A BETTER CHANCE (Reg. No. 4,825,016)

arguing that well-known and common phrases, as evidenced by these registrations, can be source-identifying marks for scholarship services.³⁵ However, Applicant did not submit accompanying evidence that the third-party marks are common expressions widely used by a number of different entities on a variety of goods and services. *Brunetti*, 2022 USPQ2d 764, at *36. Applicant “has not provided any evidence that consumers regularly encounter these [third-party marks] used in the same way as the mark in question, namely, as an expression that is commonly used as such on a wide variety of goods.” *Brunetti*, 2022 USPQ2d 764, at *36. Moreover, and importantly, the Office’s registration of the foregoing marks does not bind us here. *In re Nett Designs, Inc.*, 236 F.3d 1339, 57 USPQ2d 1564, 1566 (Fed. Cir. 2001) (“Even if some prior registrations had some characteristics similar to Nett Designs’ application, the PTO’s allowance of such prior registrations does not bind the Board or this court.”); *Brunetti*, 2022 USPQ2d 764, at *6 (“[I]t is well settled that the USPTO must examine every application on the facts presented for compliance with statutory eligibility requirements, and every case is necessarily different.”); *In re USA Warriors Ice Hockey Program, Inc.*, 122 USPQ2d 1790, 1793 n.10 (TTAB 2017) (prior decisions and actions of other trademark examining attorneys in registering other marks have

³⁵ *Id.* at 11-12; November 3, 2022 TEAS Request for Reconsideration after Final Office Action at TSDR 11-12, 18-56.

Serial No. 90525583

little evidentiary value and the Board is not bound by prior decisions involving different records). Each case must be decided on its own merits.

II. Conclusion

Based on the record as a whole, Applicant's proposed mark WHEN THERE ARE NINE fails to function as a mark for Applicant's services. WHEN THERE ARE NINE would be perceived by consumers as a widely used phrase showing support of Justice Ginsburg and women in the legal profession and thus, merely informational in nature rather than a source-indicator of Applicant's service.

Decision: The refusal to register is affirmed.